



Docket No. 13784.105005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Edward James Rozhon et al.

Group Art Unit: 1651

Serial No.: 09/712,033

Examiner: Marx, Irene

Filed: November 14, 2000

Confirmation: 9130

For: Enteric Formulations of Proanthocyanidin Polymer Antidiarrheal Compositions

REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is to request correction of the Patent Term Adjustment under Rule 705. Specifically, the Patent Term Adjustment calculation included with the USPTO communication of November 7, 2007 omits the period of adjustment under Rule 703(b). The \$200 fee required by Rule 18(e) is authorized herewith. This application is not subject to a terminal disclaimer.

Pursuant to Rule 703(b), the Office was to grant a term adjustment for the number of days that exceeds 36 months from the filing date of the application to the issue date of the application, excluding

- 1) the period following the filing of an RCE,
- 2) (i) following the declaration of an interference,
(ii) the period of suspension of prosecution due to an interference,
- 3) the period the application is under seal, and
- 4) the period of appeal.

Where a notice of appeal is filed, the period of adjustment under this paragraph "restarts" upon the mailing of a non-final office action (See Rule 703(b)(4)). The calculation of periods for Patent Term Adjustment follows.

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Calculation of Periods for Patent Term Adjustment

Under Rule 703(b)

The application was filed on November 14, 2000, and the period exceeding 36 months begins November 14, 2003. A first Notice of Appeal was mailed on January 28, 2005. The period from November 14, 2003 to January 28, 2005 is 441 days.

A non-final Office action was mailed on March 21, 2005, restarting the period under Rule 703(b). A second Notice of Appeal was mailed on February 26, 2006, followed by an RCE which was filed September 27, 2006. The period between March 21, 2005 (restart) and February 26, 2006 (2nd Notice of Appeal) is 343 days.

Thus, the total period of USPTO delay under Rule 703(b) is 784 days (441 days plus 343 days).

Under Rule 703(a)

Applicants agree with the USPTO determination that the PTO incurred 554 days delay under 703(a) for the period beginning 14 months from filing (i.e. January 14, 2002) until the mailing of a Restriction Requirement on July 22, 2003.

Reduction Under Rule 704

Applicants do not dispute the USPTO determination of 595 days of Applicant delay.

Period of Patent Term Adjustment

The period for patent term adjustment should be the sum of non-overlapping days under Rules 703(a) and 703(b) minus the days of Applicant delay.

In Form PTOL-85, mailed November 7, 2007, the USPTO calculated that the Applicants are entitled to 0 days of patent term adjustment. In the "Patent Term Adjustment" tab in the official image file wrapper (Private-PAIR) for this application, the USPTO does not include a value for the USPTO's delay under Rule 703(b). The USPTO has previously indicated that its policy is to view Rule 703(a) delays occurring before three years from filing as overlapping with Rule 703(b) delays occurring after three years from filing. See Federal Register, vol. 69, no. 118, page 34384, footnote 5, June 21, 2004. The USPTO has failed to follow its own policy in finding 0 days of patent term adjustment. Using its own interpretation, the USPTO should have arrived

at a patent term adjustment of 189 days. In other words, the USPTO should have found 784 days of delay under Rule 703(b) (which by USPTO interpretation overlaps with and, thus, also encompasses, the 554 days of delay under Rule 703(a)) and 595 days of Applicant delay. The calculation of $784 - 595$ yields 189 days of patent term adjustment using the USPTO's interpretation of the statute.

However, the plain reading of the statute does not permit the USPTO to excuse one delay simply because they caused another delay. Applicants believe that in this case the delays under Rules 703(a) and 703(b) are non-overlapping. In other words, the USPTO delay from January 14, 2002 until July 22, 2003 (delay under Rule 703(a)) does not overlap with the two USPTO delays from from November 14, 2003 to January 28, 2005 and from March 21, 2005 to February 26, 2006 (delays under Rule 703(b)), respectively. Therefore, Applicants are entitled to the sum of all the delays minus the days of Applicant delay, yielding a calculation of $(784 + 554) - 595 = 743$ days.

Summary of Requested Correction to PTA

The patent term adjustment of 0 days according to USPTO Form PTOL-85, mailed November 7, 2007 is incorrect because it does not include delays under Rule 703(b).

Applicants request that the patent term adjustment be corrected to add **743 days** of term as follows:

- 1) changed from 0 days to 189 days according to the USPTO's stated policy, and
- 2) changed from 189 days to the correct value of 743 days, according to the plain language of the statute rather than USPTO's misinterpretation of the statute.

AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 13784.105005. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 13784.105005. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee

for such an extension of time or credit any overpayment for an extension of time to Deposit
Account No. **50-3732**, Order No. 13784.105005.

Respectfully submitted,
King & Spalding, LLP

Dated: November 16, 2007

By:



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